

**REMARKS**

**1) Summary of Office Action**

The Applicant thanks the Examiner for the Office Action, made 'Final' of February 16, 2007.

The rejections remain as before. Claims 36 to 55 are currently pending in this application. In the Office Action of May 4, 2006, all of claims 36 to 55 were rejected under 35 U.S.C. 103(a) as being obvious in light of various combinations of references, as follows:

- (a) Claims 36 to 39, 41 and 42 are rejected as being obvious given US 4,796,758 of Hauk in view of US 5,090,526 of Jacober (No.1).
- (b) Claim 40 stands rejected in view of Hauk and Jacober No. 1, further in view of Young.
- (c) Claims 43 – 46 and 48 – 55 stand rejected given US 5,865,314 of Jacober (No. 2) in view of Jacober No. 1.
- (d) Claim 47 stands rejected in view of Jacober No. 2 and US 6,092,661 of the Mogil.

**2) Commentary on Rejections under 35 USC 103 – Underlying Law**

Once again, the Applicant respectfully traverses all of the present rejections, and requests their reconsideration and withdrawal. Notwithstanding the amendments made herein, the Applicant reserves its right to pursue any or all of the present claims as they stood prior to amendment by way of division or continuation at such time as may be appropriate. The Applicant explicitly does not intend by these amendments to surrender any scope under the doctrine of equivalents either with respect to the claims as they

formerly stood, or with respect to the claim scope to which the Applicant would have been entitled had the claims been originally submitted in the manner in which they stand as amended.

In the interests of brevity, the Applicant repeats and incorporates by reference the statements of law previously submitted in this matter.

**3) Commentary on References and Claim Amendments**

The Applicant notes that the Examiner has found the Applicant's previous argument that Hauk is not soft-sided to be persuasive.

The Applicant respectfully submits that the rejections do not meet the three part test established in law, and summarized in MPEP 2142, because:

(1) the Jacober ('526) reference does not have the features of the claim, notwithstanding the Examiner's commentary and the enlarged reproduction of a portion of Jacober's illustrations; and

(2) whether Jacober has the features the Office Action contends that it has or not (and the Applicant contends that it does not), there has been no reason given to combine or modify any of the evidence of record in this case.

**Jacobер – Rectangular Shape**

The Examiner points to Jacober Figure 2, and has circled the radiused corner portions of Jacober's apparatus as demonstrating "downwardly concave portions of the end walls".

The Applicant does not agree that this establishes that Jacober shows or describes the recited feature. The law requires that the Jacober reference be read as a whole. Jacober clearly states, in the "Summary of the Invention" (Col 2, lines 15 – 39):

## “SUMMARY OF THE INVENTION”

“In accordance with these and other objects, *the present invention*, in its broadest aspects, *provides a self-supporting soft walled carrier*. *The carrier comprises a plurality of pliable panels* including an upstanding end panel, a pair of upstanding side panels, a top panel and a bottom panel. The panels are joined together at their respective edges to form a shaped compartment defining an inner body cavity having a *rectangular* mouth opening opposite the end panel. The carrier further includes a *rectangular end cover panel* for selectively opening and closing the mouth opening. A removable end panel insert is provided which is adapted to be selectively abuttingly engaged against the end panel within the body cavity. The top, bottom, side, end cover and end insert panel members are each provided with a resilient pliable construction. The end panel has simply a pliable construction. The resilient pliable panels permit the carrier to be self-supporting and upstanding in a tall and thin vertically oriented position. The carrier further includes closure means for securing the cover to the body. The closure selectively joins or disjoins less than the *full rectangular periphery of the cover panel*. The remainder of the full periphery is hingeably attached to the body of the carrier.” (Emphasis added).

The Examiner is expected to employ the broadest reasonable meaning that can be supported by the claim language. Indeed, it is the Examiner’s duty to the public to do so. However, no matter how broadly the language is interpreted, it cannot be interpreted to say something that it does not.

The cited reference says “rectangular”, not once, not twice, but three times in one paragraph, and a further 16 times throughout the document, including multiple repetitions in the claims. The document does not say “concave” as in claim 34, or “downwardly widening” as in claim 43. Whatever the quality or accuracy of Jacober’s illustrations may be, the Applicant respectfully submits that Jacober’s text should be taken as being accurate on its face, and given its plain, ordinary and customary meaning. Whatever may appear to be shown, in the Examiner’s view, the Applicant respectfully submits that the plain and ordinary meaning of “rectangular” is neither consistent with the object being “concave” nor with it being “downwardly widening”. If

Jacober says that the wall is rectangular (and at least 19 times, at that), the Applicant respectfully submits that the Examiner is obliged to accept that description.

The Applicant respectfully submits that notwithstanding the commentary in the Office Action, Jacober does not have the features of claim 36 or 43. On that basis alone, the Applicant respectfully requests that the rejections be reconsidered and withdrawn.

**Jacober – Upper and Lower Portions – Claims 36 and 43**

The Office Action suggests that Jacober shows the feature of a movable panel that divides Jacober into upper and lower portions.

Claim 36 calls for a rectangular panel that conforms to the lower margins of the first and second end walls of the upper portion, and the front and rear margins of the spanning wall. The rectangular shelf is not near any margin of these walls. Or, to the extent that the Examiner has a different interpretation, the Applicant respectfully requests that the Examiner identify the walls and the lower margins or the front and rear margins of Jacober that correspond to the claim language.

Claim 36 calls for the rectangular panel to be movable relative to the lower portion when the closure member is in an open condition. But if the panel is removed as suggested in the office action, then Jacober no longer has upper and lower portions but merely one big open space: Jacober's walls have no other demarcation.

Claim 36 calls for the upper portion to be movable relative to the lower portion. Jacober is a unitary structure. The Examiner suggests that the shelf be removed. When it is removed, there is, apparently, no longer an upper portion and a lower portion,

but merely one portion. It is difficult to see how the portions could then be said to be "movable" relative to each other.

Claim 36 calls for the upper portion to be securable in a fixed position relative to the lower portion. Where does Jacober provide this?

Claim 36 calls for a first closure member and a second closure member. Jacober has a single unitary closure member.

Claim 43 calls for the upper and lower portions to be hingedly connected. Jacober has no such feature, and Jacober's shelf is not located anywhere near any hinge.

Claims 43 calls for Jacober doesn't have a "downwardly widening profile". Jacober describes a rectangle.

Claim 43 calls for first and second closure members. Jacober has a single closure member.

Claim 43 calls for the upper portion to have front and rear margins. Jacober appears not to have any such feature.

Claim 43 calls for the bottom wall of the upper portion to be permanently connected. Surely if the Office Action now touts the removability of Jacober's shelf, that must be an admission that it is not permanently connected. Given that references have to be read as a whole, and interpreted in a consistent manner, clearly then, at the very least one or the other of claims 36 and 43 must be allowable, on the basis of the Examiner's own commentary. For if the Examiner relies upon the removability of Jacober's shelf in any way to support any of the rejections, then that very removability must be contrary to the claimed invention of claim 43 and its dependencies. The

Applicant respectfully requests, therefore, that the Examiner clarify whether the Office Action commentary is intended to support the rejection of claim 36, or to indicate the allowability of claim 43, or both.

In sum, given the litany of differences, the inference is irresistible that Jacober has not been chosen because of any objectively identifiable reason to combine, but rather because it has soft sided walls and rounded corners which can be plucked selectively from the reference, out of context, to supply (in the Examiner's view) the missing features according to the road map set out by the Applicant's claims. But that is the essence of an impermissible hindsight analysis.

#### **Reason to Combine**

The Office Action suggests that sufficient reason to combine can be found in the assertion that Hauk and Jacober are "analogous art" and thus are "capable of being combined".

As a preliminary matter, the Applicant does not concede (a) that Jacober is analogous art, or (b) that there has been a demonstration in the Office Actions of any evidence to support the assertion that they are. Jacober is about collapsible, soft, backpacks for "clothing, sporting goods and the like", and says nothing about coolers. Hauk is about substantially rigid cooling chests for expressed milk. There is no evidence of record in this case that establishes that these are "analogous arts".

Even if they were analogous art, (which the Applicant does not concede), "capable of being combined" is not, and never has been, the test under the law. The issue is not whether references can be combined, but rather whether they would be combined. (*In re Mills*, 916 F. 2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990). The law still

requires that a reason to combine be demonstrated in the objective evidence of record. The reason need not necessarily be the same as that of the present inventors, but there must be some objective reason demonstrated nonetheless.

The Examiner suggests that it would be obvious to convert the substantially rigid cooler of Hauk into a soft side cooler employing the soft sided back pack structure of Jacober. ( The Applicant notes again that Jacober is not itself a cooler, in any event).

The Applicant respectfully disagrees. Hauk teaches that:

(1) "The portable case includes several components, a *durable and rugged case*, an insulated chest, storage bottles and chilling means." (Abstract, second sentence, emphasis added).

(2) "Inside the interior cavity or chamber **23** is an insulated chest **24**, *such as of one-inch (1") thick expanded polystyrene foam, with a fitted lid 25*. The foam acts as an *insulation and protection device* for the chilling means and storage bottles. *The shaped walls* of the chest **24** force the chilling means, such as, for example, coolant bags, to press against and conform to the storage bottles." (Col. 3, lines 43 – 50, emphasis added.)

(3) "Chest **24** is generally *rectangular* in shape." (Col. 3, lines 55 – 56, emphasis added).

Of these, the desire for a "*durable and rugged case*", the "*one inch thick expanded polystyrene foam*", the "*fitted lid*", the function as a "*protection device*", and the "*shaped walls*" that "*force*" the coolant bags against the storage bottles all teach substantially rigid structure, and away from soft sided elements such as those of

Jacober. "Teaching away" is the classic hallmark of non-obviousness, the very antithesis of motivation to combine or modify.

Further, when Hauk tells us that the cases is "generally rectangular in shape" and even gives measurements for height, width and depth. It is difficult to see how that statement is that consistent with motivation to make it something other than rectangular in shape.

The Office Action of February 16 posits that there is motivation to modify demonstrated at Jacober col. 1, lines 19 – 25. The Applicant disagrees. While reduction in weight and overall cost of manufacturing may be attractive, as a general abstract proposition, if the proposed modification makes the reference unsuitable for its intended use then there cannot be motivation to make the proposed change cannot be made. It is not abstract reasoning, but a reason to modify a device of the nature of Hauk that is required.

The Applicant respectfully submits that not only has there been no demonstration of a reason to combine, but, further, Hauk teaches away. In that light, the Applicant again respectfully requests that the rejections be reconsidered and withdrawn; and that the claims be allowed.

**4) Claims 56 and 57**

Claims 56 and 57 have been added. The Applicant respectfully submits that both of these claims are allowable over the art of record in this case.

**5) Conclusion**

For the foregoing reasons, and in view of the previously made amendments, the Applicant respectfully submits that claims 36 – 55 are presently allowable. The

Applicant respectfully requests that the current rejections be withdrawn, and that the case be passed to allowance.

Should the Examiner determine that any further action is necessary to place this application into condition for allowance, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300 with reference to Attorney Docket No. 027699-00005.

Respectfully submitted,

Arent Fox LLP



Charles M. Marmelstein  
Attorney for Applicants  
Registration No. 25,895

**Customer No. 004372**  
1050 Connecticut Ave., N.W.  
Suite 400  
Washington, D.C. 20036-5339  
Telephone No. (202) 857-6000  
Facsimile No. (202) 857-6395